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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,270	12/20/2000	Michael Gargiulo	042933/316979	2797

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EXAMINER

LEE, PHILIP C

ART UNIT	PAPER NUMBER
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2152

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/746,270

Applicant(s)

GARGIULO ET AL.

Examiner

Philip C. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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1. This action is responsive to the amendment and remarks filed on December 28, 2006.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/28/2006 has been entered.
3. Claims 11-36 are presented for examination and claims 1-10 are canceled.
4. The text of those sections of Title 35, U.S. code not included in this office action can be found in a prior office action.

Claim Rejections - 35 USC 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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6. Claims 33, 35, and 36 are rejected under 35 U.S.C. 101 because “An apparatus” that does not include any functional structure of an apparatus is considered as program per se, which is not one of the categories of statutory subject matter.

Claim Rejections - 35 USC 103

7. Claims 11-36 are rejected under 35 U.S.C. 103(a) as being unpatentable Dusse et al, U.S. Patent 6,647,260 (hereinafter Dusse).

8. Dusse is cited in the previous office action.

9. As to claims 11, 31, and 36, Dusse discloses the invention substantially as claimed including a method for downloading media content sent over a communication system to a mobile station (Fig. 1., and abstract), the method comprising:

requesting media content by sending message with a header including a mobile identification number from said mobile station (provisioning request, and device identification information, col. 5, lines 6-10,15-16); receiving a message with said media content (content and related notifications, col. 7, lines 32-34, 60-62), a reply Universal Resource Locator (URL) identifying a server and a transaction identification at said mobile station (col. 7, lines 35-38); temporarily saving the media content within said mobile station and previewing at least a portion of the media on the mobile station (terms conditions and related information are pushed to the mobile station, hence, temporarily stored, until it is previewed and accepted, col. 8, lines 35-47), the previewed portion of

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said media content comprising a portion of said media content specifically requested (content and related notifications combined are considered as "media content" specifically requested, and related notifications are the portion being previewed, col. 7, lines 42-62; col. 8, lines 33-38); sending a primitive with the mobile identification number to the server identified by the URL from said mobile station (col. 6, lines 55-58; and col. 7, lines 35-40); and permanently saving the media content within the mobile station only when permission to save has been received (col. 7, lines 32-40; col. 8, lines 41-45).

10. Dusse does not explicitly disclose a reply URL identifying a server and transaction identification as part of the received message. However, Dusse discloses that the content forwarded to the mobile station included information required to communicate with limited access commercial services devices (col. 7, lines 32-41). It would have been obvious to one skilled in the art at the time of the invention that such information would include a URL for "say" a billing service, as well as transaction identification in order to facilitate billing charges for accounting purposes.

11. As to claims 12 and 32, Dusse discloses said message with said media content, said reply URL and said transaction identification conforms to a Multimedia Internet Mail Extension (MIME) format (col. 7, lines 32-36; and col. 8, lines 38-40).

12. As to claims 13 and 14, Dusse discloses sending a message from said mobile station to said server to update a usage record employing said reply URI, when said

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mobile station uses said media content (col. 5, lines 15-21; col. 6, lines 55-57; col. 7, lines 63-67; and col. 8, lines 1- 4). It would have been obvious to one skilled in the art at the time of the invention that this billing activity should lead to user receiving a bill indicating use of said media content by said mobile station.

13. As to claim 15, Dusse discloses the communication system includes a secure connection between said mobile station and said server (col. 8, lines 5-12).

14. As to claims 16, 33, 34, and 35, the claim is rejected for the same reasons as claims 11-14 above. In addition, Dusse discloses a method of downloading media content to a mobile station (Fig. 1; and abstract), comprising: requesting "a ring tune deck" from a media server by entering a Universal Resource Locator (URL) thereof (col. 3, lines 28-30; and col. 5, lines 12-14); providing a media deck corresponding to said ring tune deck to said mobile station, selecting a category from said media deck, providing specific links to ring tuned based on said category selected from said media deck, and selecting a ring tune from said specific links to said ring tunes (providing a menu and selecting a menu item out of another menu items is known in the art, e.g. col. 5, lines 40-65; and Fig. 2); generating a transaction number based on selecting "said ring tune" (content may include information to communicate with commercial server devices for billing, i.e. transaction information, col. 7, lines 35-40) and sending a file that conforms to a Multimedia Internet Mail Extension (MIME) format with "a ring tune" (col. 7, lines 32-36; and col. 8, lines 38-40) and a reply URL (content may include information to communicate with commercial server devices col. 7, lines 35-38) to said mobile station (col. 8, lines 34-

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40); verifying a format of said file and temporarily storing said file within said mobile station (terms, conditions and related information are pushed to the mobile station, hence, temporarily stored, until it is previewed and accepted, col. 8, lines 35-47); generating a primitive using said reply URL (col. 6, lines 55-58; and col. 7, lines 35-40) upon acceptance of said file and sending an acceptance message to said media server (col. 8, lines 41-51); creating a usage record from said acceptance message (col. 5, lines 15-21; col. 6, lines 55-57; col. 7, lines 63-67; and col. 8, lines 1-4); transmitting a confirmation reply message to said mobile station (776, Fig. 7C); permanently storing said file within said mobile station only when permission to save has been received (col. 7, lines 32-40; col. 8, lines 41-45), and reporting and updating said usage record upon use of "said ring tune" employing said reply URL (col. 7, line 63 to col. 8, line 4).

15. Dusse does not explicitly disclose downloading a ring tune deck to select a ring tune. However, Dusse discloses downloading other service features such as provisioning services to the mobile station. It would have been obvious to one skilled in the art at the time of the invention that Dusse's method and system can be utilized to use a service server to download any type of service requested by a user including a ring tune deck for the selection of a ring tune.

16. As to claims 17-19, Dusse discloses said URL is selected from a pre-stored list of URLs, viewing a plurality of URLs on a special menu of a display of said mobile station, and pressing a selected URL on a special menu of a display of said mobile station to invoke a browser thereof (col. 5, lines 50-65).

17. As to claim 20, Dusse discloses the request includes a header with a mobile identification number of said mobile station (provisioning request, and device identification information, col. 5, lines 6-10,15-16).

18. As to claim 21, Dusse discloses a carrier network routes said request to said media server through an Internet via a wireless application protocol gateway (Fig. 1; and col. 4, lines 27-43).

19. As to claim 22, Dusse discloses said specific link to said ring tunes is shown on a display of said mobile station (col. 5, lines 40-65; and Fig. 2).

20. As to claim 23, Dusse discloses selecting said ring tune is performed by scrolling through said specific links to ring tunes using a scroll key and soft keys or depressing a key of said mobile station (col. 5, lines 40-65; and Fig. 2).

21. As to claim 24, Dusse discloses the reply URL is programmably generated by said media server (content may include information to communicate with commercial server devices, col. 7, lines 35-38).

22. As to claim 25, Dusse discloses generating a database record associated with said transaction number (col. 7, line 63 to col. 8, line 4).

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23. As to claim 26, Dusse discloses said file further includes said transaction number and a label tag (content may include information to communicate with commercial server devices col. 7, lines 35-38).

24. As to claim 27, Dusse discloses discarding said file, or accepting said file following said act of verifying (col. 8, lines 34-45). As Dusse does not disclose downloading "a ring tune", he obviously does not disclose listening to said ring tune. However, approval by the user prior to implementation (col. 8, line 38) amount to previewing before acceptance for the pushed information, so if this information is audio information, then obviously "listening" is previewing.

25. As to claim 28, Dusse discloses storing said usage record on a transaction server (col. 7, line 63 to col. 8, line 4).

26. As to claim 29, Dusse does not necessarily disclose providing a credit based on selecting "said ring tune" or any service feature. However, it would have been obvious to one skilled in the art at the time of the invention that many of billing policies may be implemented in the billing server, obviously including providing a credit based on selecting a specific service feature.

27. As to claim 30, Dusse discloses updating a bill for said mobile station based upon said usage record (col. 7, line 63 to col. 8, line 4).

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28. Applicant's arguments with respect to claims 11-36, filed 12/28/06, have been fully considered but are not deemed to be persuasive.

29. In the remark applicant argued that

(1) Dusse fails to teach temporarily saving the media content within the mobile station and previewing at least a portion of the media content on the mobile station in which the previewed portion of the media content comprises a portion of the media content specifically requested.

(2) Dusse fails to teach permanently saving the media content within the mobile station only when permission to save has been received.

30. In response to point (1), Dusse teaches receiving of content and related notifications (col. 7, lines 60-62). The content and related notifications combined are considered as "media content". Dusse teaches upon processing of a request from the mobile station, terms, conditions, and related notifications are pushed to the mobile station for approval by a user (col. 8, lines 34-38). This means the terms, conditions, and related notification must be temporarily stored within the mobile station until it is preview by the user. Since content and related notification combined are interpreted as "media content", terms, conditions, and related notification that are sent to the user in response to a content request are considered as at least a portion of the "media content" previewed and the previewed portion of the media content (terms, conditions, and

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related notification) comprises a portion of the media content specifically requested (i.e., terms, conditions, and related notification are part of the "media content" specifically requested) .

31. In response to point (2), Dusse teaches after preview by a user, the user can accept the terms, conditions, and related information associated therewith. If the user accepts then, content is forwarded and stored on the mobile station (i.e., permanently stored, col. 8, lines 35-47; col. 7, lines 32-40). This means the user acceptance is considered as "permission to save" that prompted the forwarding and storing of the content on mobile station. If the user declines, content will not be saved on the mobile station.

32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Routtenberg et al, US 2002/0049717; Zilliacus et al, US 2004/0160911; Cooper et al, US 5,689,560 disclosed a method of temporarily saving media content and previewing a portion of said media content that is specifically requested.

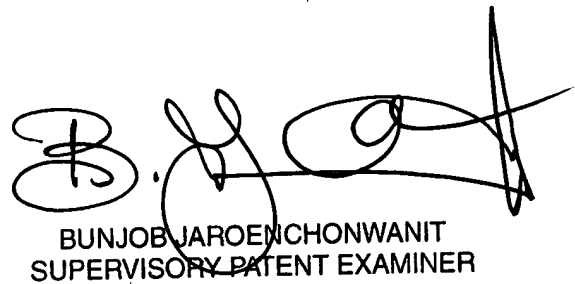
33. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Lee whose telephone number is (571)272-3967. The examiner can normally be reached on 8 AM TO 5:30 PM Monday to Thursday and every other Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob

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Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

P.L.



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